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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/567,586

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Kazuo Hirai

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EXAMINER

NERANGIS, VICKEY MARIE

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

05/07/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/567,586	Applicant(s) HIRAI, KAZUO	
	Examiner VICKEY NERANGIS	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/8/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claim 3 is objected to because “hydrocarbon-bases” is a typo of --hydrocarbon-based-- and should read as such.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 3, the term “the hydrocarbon-bases wax” lacks antecedent basis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4, and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP ‘048 (JP 2000-265048, machine translation).

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JP '048 discloses a thermoplastic resin composition for use in a sliding member (abstract) comprising 100 parts by weight (pbw) of polyester such as polybutylene terephthalate, 10-100 pbw bisphenol resin such as phenoxy resin (paragraphs 0026 and 0041), a phosphate such as lithium phosphate (paragraph 0061) in an amount of 1-20 pbw per 100 pbw of total polybutylene terephthalate and phenoxy resin (paragraph 0084), and 0.5-18 pbw of an olefin polymer as compatibilizing agent per 100 pbw total polybutylene terephthalate and phenoxy resin (paragraph 0053). In Table 1, the amount of phosphate is 10 pbw and the amount of compatibilizing agent is 5 pbw per 100 pbw total polybutylene terephthalate and phenoxy resin. Given that polybutylene terephthalate is reads on the aromatic polyester of claim 2. Furthermore, the polyester can also be polyhydroxybenzoic acid (paragraph 0019) which reads on the additional aromatic polyester of claim 2 given that mixtures of ingredients are *prima facie* obvious.

While JP '048 does not exemplify a sliding member comprising a phenoxy resin or a bisphenol resin in an amount like presently claimed, this does not negate a finding of obviousness under 35 USC 103 since a preferred embodiment such as an example is not controlling. Rather, all disclosures "including unpreferred embodiments" must be considered. *In re Lamberti* 192 USPQ 278, 280 (CCPA 1976) citing *In re Mills* 176 USPQ 196 (CCPA 1972). Therefore, it would have been obvious to one of ordinary skill in the art to utilize a phenoxy resin in amounts like claimed given that JP '048 teaches such.

With respect to claim 7, this claim further limits polyamide but does not exclude the alternative embodiment of aromatic polyester. Since the latter embodiment is disclosed by JP '048 as discussed above, it is proper to include claim 7 in this rejection.

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4. Claims 1-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohkawachi et al (US 5,677,055).

Ohkawachi et al discloses a polyester resin stretched film comprising 100 parts by weight (pbw) thermoplastic polyester such as preferred polybutylene terephthalate (col. 3, lines 13-14); 3-100 pbw modified olefin based resin (i.e., compatibilizing agent) (col. 3, line 19 to col. 5, line 16) such as ethylene-glycidyl methacrylate copolymers (col. 4, lines 17); 1-10 pbw low molecular weight polyethylene resin (col. 5, lines 17-22); such as exemplified polyethylene wax (Table 1, component C); 1-10 pbw bisphenol epoxy resin (i.e., phenoxy resin) (col. 5, lines 23-29); and optionally an inorganic filler such as calcium carbonate in amount not greater than 300 pbw (col. 5, lines 40-44). Regarding claim 2, the thermoplastic polyester is the aromatic polyester resin, too.

Given that Ohkawachi et al teaches that calcium carbonate can be added in an amount of up to 300 pbw to the polyester resin stretched film, it would have been obvious to one of ordinary skill in the art to utilize calcium carbonate as a filler in amounts like presently claimed.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. "sliding" member, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art invention and further that the prior art structure which is a composition identical to that set forth in the present claims is capable of performing the recited purpose or intended use. Case law holds that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior

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art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

With respect to claim 7, this claim further limits polyamide but does not exclude the alternative embodiment of aromatic polyester. Since the latter embodiment is disclosed by Okhawachi et al as discussed above, it is proper to include claim 7 in this rejection.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Nerangis whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

5/6/2009

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/Vickey Nerangis/

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